

REMARKS/ARGUMENTS

1. Summary of the Office Action

Claims 15-18, 20, 22-23, and 25-27 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Collins et al. (US Patent Number 5,781,714, issued on July 14, 1998) in view of Lipton (US Patent Number 5,940,581, issued on August 17, 1999).

Claims 1-14 and 28-30 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Simon et al. (US Patent Number 6,065,008, filed on October 1, 1997) in view of Collins et al. (US Patent Number 5,781,714, issued on July 14, 1998) further in view of Lipton (US Patent Number 5,940,581, issued on August 17, 1999).

Claims 19 and 24 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Collins et al. (US Patent Number 5,781,714, issued on July 14, 1998) in view of Lipton (US Patent Number 5,940,581, issued on August 17, 1999) as applied to claims 8, 15, and 22 above, and further in view of Simon et al. (US Patent Number 6,065,008, filed on October 1, 1997).

2. Response to § 103 Rejections

Applicants respectfully traverse this rejection for the reasons set out below, and ask the Examiner for reconsideration.

*To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable*

expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. THERE IS NO SUGGESTION OR MOTIVATION TO COMBINE LIPTON WITH COLLINS OR SIMON

The combination of Lipton and Collins or Lipton and Simon is erroneous, because no suggestion or motivation to combine these references can be found in the references themselves. The Office Action asserts that it would have been obvious to one of ordinary skill in the art to have combined Lipton with Collins or Simon, because “it would have always assured that the document will be imaged in the most efficient manner that is consistent with the capabilities of the device.” (Office Action mailed 07/27/04, p. 4.) The Office Action is silent with respect to where a motivation to combine can be found in the reverences. Indeed, Lipton asserts that its invention provides that “the user is *always* assured that the document will be imaged in the most efficient manner that is consistent with the capabilities of the device.” (Lipton, 2: 49-51.) Therefore, according to Lipton, there is no motivation whatsoever to combine Lipton with any other reference in order to achieve this result. On the other hand, there is nothing in Collins or Simon to suggest a combination of either or both of these references with Lipton.

The motivation to combine Lipton and Collins or Lipton and Simon is suggested solely by hindsight in view of the inventions of claims 1, 15, 22, or 28. Accordingly, Applicants respectfully request the Examiner to withdraw the obviousness rejections of claims 1, 15, 22, or 28 and their respective dependent claims.

B. COLLINS AND LIPTON DO NOT TEACH OR SUGGEST ALL LIMITATIONS OF CLAIMS 15, WHEN CONSIDERED SINGULARLY OR IN COMBINATION

Claim 15 reads as follows:

15. A method for dynamic font subsetting, comprising:
sending a first request from an electronic device to an intermediate network device for electronic content on a computer network;

responsive to the sending of the first request for the electronic content, receiving modified electronic content **from the intermediate network device** on the electronic device, wherein the **modified electronic content is created responsive to the first request and includes one or more directives**, wherein a directive identifies a glyph sub-set including a set of glyphs identified in the modified electronic content and an encoding scheme used to encode the set of glyphs;

processing the modified electronic content, thereby identifying the one or more directives;

sending a plurality of second requests to the intermediate network device based on the one or more identified directives to request one or more glyph sub-sets to allow the electronic device to display the modified electronic content; and

receiving one or more glyph sub-sets **from the intermediate network device**; and

displaying the modified electronic content using the one or more glyph sub-sets.

i. **Collins and Lipton do not teach or suggest an intermediate network device of claim 15 reciting, when considered singularly or in combination**

Collins, Lipton, and a combination thereof fail to disclose “**sending a first request from an electronic device to an intermediate network device** for electronic content on a computer network” or “**receiving modified electronic content from the intermediate network device**,” as required by claim 15.

As submitted in the previous response, Collins, whether considered separately or in combination with Simon, discloses “**receiving a first request on an intermediate network device from an electronic device for electronic content**”, as required by claim 1. The Office Action is silent with respect to this limitation in the “Claim Rejections” section, as well in the “Response to Arguments” section. It is thus understood that the absence of this limitation in Collins, whether considered separately or in combination with Simon is not contested.

In Lipton, when an imaging operation, such as printing, commences, the document is examined to identify characters that are contained in the document, fonts appearing in the document are detected, and a database is constructed to store the fonts, and the characters within these fonts, that are identified. Thus, Lipton also fails to disclose “**receiving a first request on an intermediate network device** from an electronic device for electronic content” or “receiving modified electronic content from the **intermediate network device**,” as required by claim 1, whether considered separately or in combination with Collins and Simon.

ii. **Collins and Lipton do not teach or suggest the modified electronic content created responsive to the first request, as required by claim 15, when considered singularly or in combination**

The Office Action admits that Collins fails to disclose “receiving modified electronic content ..., wherein **the modified electronic content is created responsive to the first request and includes one or more directives**,” as required by claim 15. (Office Action mailed 7/27/04, p. 3.) The Office Action combined Collins and Lipton to show the “responsive” element of claim 15. The Office Action states that Lipton discloses a method in which, at the time of the request for imaging (e.g., printing), a font subset is generated and processed for the requested document. (Office Action mailed 7/27/04, p. 3.) However, claim 1 requires that “**the modified electronic content is created**” responsive to the first request for electronic content, which is distinct and in stark contrast with the method of Lipton, where the required characters are remapped to a sparse font if one or more required characters are not present in the device. (Lipton, 2: 26-48.)

Furthermore, when an imaging operation, commences in Lipton, the required characters are remapped to a sparse font if one or more required characters are not present in the device. (Lipton, 2: 26-48.) Thus, in Lipton, *responsive to* an imaging operation such as *printing*, (i.e., an operation distinct and unrelated to a “**request ... for electronic content**”), the required *characters are remapped to a sparse font* (i.e., an operation distinct and unrelated to “**receiving modified electronic content**, wherein **the modified electronic content includes one or more directives**”). The Applicants submit that, although Lipton discloses *a subsequent operation being performed responsive to a preceding request*, the combination of Collins and Lipton does not yield “receiving modified electronic content ..., wherein **the modified electronic content is**

created responsive to the first request and includes one or more directives,” as required by claim 15.

Because not every element of claim 15 is disclosed in Collins and Lipton, whether considered singularly or in combination, claim 15 and its dependent claims 16-21 are patentable over Collins and should be allowed.

**C. COLLINS AND LIPTON DO NOT TEACH OR SUGGEST ALL LIMITATIONS OF
CLAIM 22, WHEN CONSIDERED SINGULARLY OR IN COMBINATION**

Claim 22 requires **the directives being inserted in the requested electronic content**. Therefore, claim 22 and patentable and its dependent claims 23-27 should be allowed for at least the reasons articulated with respect to claim 15.

**D. COLLINS, SIMON AND LIPTON DO NOT TEACH OR SUGGEST ALL LIMITATIONS
OF CLAIMS 1 AND 28, WHEN CONSIDERED SINGULARLY OR IN COMBINATION**

Claims 1 and 28 require “**inserting one or more directives in the requested electronic content**” and a “**modified electronic content created responsive to a request for the electronic content and including one or more directives**” respectively. Therefore, claims 1 and 28 and their respective dependent claims 2-14 and 29-30 should be allowed for at least the reasons articulated with respect to claim 15.

3. Conclusion

In light of the above, Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Elena Dreszer at (408) 947-8200 ext. 209.

Respectfully submitted,
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